

*Application No. 09/915029  
Page 6*

*Amendment  
Attorney Docket No. F46.2B-13069-US02*

#### **REMARKS**

This Amendment is in response to the Office Action dated September 15, 2005. Each issue in the official action is discussed below.

#### ***§101 Rejections***

Claims 1-15 were rejected under 35 USC §101 because the invention is directed to non-statutory subject matter. It is asserted in the rejection that, although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-15 are deemed to be directed to non-statutory subject matter. A full account of the rejection can be found in paragraphs 5-6 on pages 2-3 of the official action.

Applicant respectfully traverses. The rejection is improper because the test for patentable subject matter under 35 U.S.C. §101 does not include a separate "technological arts" test, according to the Board of Patent Appeals and Interferences. *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005). Pursuant to the Board of Patent Appeals and Interference's Standard Operating Procedure 2, the opinion in the above cited case has been designated a precedential opinion. As such, withdrawal of the rejection is respectfully requested.

#### ***§103 Rejections***

(8)

Claims 1-9, 11-13 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz (US 6088722) in view of Von Kohorn US 2001/0003099. A full account of the rejection may be found in paragraph 8 of the official action on pages 4-15.

Applicant respectfully traverses. The rejection fails because, not only is each and every element of the claimed invention not accounted for in the cited references; there is no cited motivation to make the combination as asserted. Only in hindsight of Applicant's application may the asserted combinations be made.

As to claims 1 and 11 and those claims dependent thereon, the claimed invention

*Application No. 09/915029  
Page 7*

*Amendment  
Attorney Docket No. F46.2B-13069-US02*

differs from the cited references in that, in Herz, customers develop an "agreement matrix" (column 4, lines 25-29) characterizing which available video programming appeals to them. This creates a customer profile which changes passively based on what a customer watches (column 14, lines 17-23). Unless a customer is on an expert or customer panel (column 13, lines 29-31), there is no commitment mentioned by Herz that a customer is to participate in future screenings.

The customer profiles used in Herz are restricted to what types of video programming are of interest to that customer or household, not in conjunction with how they characterize a particular film assigned to them. In order to conduct a test screening, such as those of the present invention, factors like a viewer's age, sex, income level, etc. are more important. The demographic information in Herz is used primarily to establish initial customer or content profiles. Once the system is initialized, Herz's primary focus is to match video programming to what a particular customer "likes" and is interested in viewing. The presently claimed invention, on the other hand, provides a screening subject with a specific video, regardless of their particular interest or likes, and obtaining information from them about the video after they have screened it.

There also appears to be no mention of a sequential selection method used in Herz, as is used in the presently claimed invention. Sequential selection offers a fast way to establish a test audience because customers are actively volunteering and do not have to be contacted and asked if they wish to participate. Herz, on the other hand, uses a clustering method.

The type of on-line response or feedback that Herz generates for a video is limited to preference ratings. Herz utilizes scales to rate the content of a video (ie. aspects of a video like the amount of violence or the level of "action") (column 14, lines 35-49). Instead of a more qualitative approach, as used in the presently claimed invention, Herz uses a generalized method applied to a wide range of similar videos. The originator of a video, however, may wish to determine how an audience reacts to specific aspects of their video (ie. did audience members "like" the ending, or could they follow the story line). Herz does not address this issue. Contrastingly, the results from the presently claimed invention can be used to aid the originator in making the video more appealing to audiences. Since Herz is not concerned with determining why audience members "like" a video, one skilled in the art would be led away from the presently claimed invention by the teachings of Herz and, absent the hindsight of Applicant's

*Application No. 09/915029  
Page 8*

*Amendment  
Attorney Docket No. F46.2B-13069-US02*

disclosure, there is no motivation to alter the teachings of Herz, as asserted in the rejection.

Still further, the lack of using a PIN number in the Herz method shows that the Herz method is not interested in providing the type of security and proper verification that would be necessary to conduct a test screening. A PIN would not only provide security for the video being test screened, which is of importance for the uses of the presently claimed invention and not similarly important to the teachings of Herz, it will help ensure accuracy of results by verifying the identity of each test audience member.

Herz offers no motivation to incorporate a higher security, as is addressed by the presently claimed invention. Herz makes scant mention of how it stores contact information for individuals who are registered. The presently claimed invention requires storing contact information in a separate database. The two-way secure transmission that Herz refers to (column 7, lines 44-54) does not prevent theft of a registrant's identity and there is no cited motivation to make any alterations.

Each disclosed process in the cited references is directed to specific things. There is no reason to believe that it would be obvious and that one would be motivated to change each process in the manner asserted in the rejection in light of the other. The purpose of each process cannot be ignored in considering obviousness.

As to claims 2 and 3, in addition to the reasons stated above, Herz makes no mention of conducting a post viewing discussion after a video is test screened, as required by the claimed invention. This is because the type of feedback that Herz is interested in obtaining is not intended to be used by an originator of a video to enhance the video being tested. Test screenings should not only provide audience preference ratings, they should provide results that may suggest how the originator can "improve" the video. There is no reason to believe that one would be motivated to alter the teachings of Herz, as asserted in the rejection.

Herz shows no regards to time constraints in gathering information on a particular video. If a video is to be test screened in a short period of time, an announcement may be necessary to expand the volunteers beyond those currently registered as customers. Those that are registered would have to actively volunteer to be included in this type of test screening unlike the expert or customer panel that Herz teaches (column 13, lines 29-31). There is no motivation to alter the teachings of Herz to conform them to the claimed invention because the purposes are

*Application No. 09/915029  
Page 9*

*Amendment  
Attorney Docket No. F46.2B-13069-US02*

distinct.

As to claim 4, in addition to the reasons stated above with regard to claim 1, the method used in Herz to store demographic information with a customer's profile concentrates more on matching a customer's preference for the content of a video to video programming that rated high amongst a cluster of customers with similar preferences. The use of demographics in clustering is relegated to the process of forming initial content or customer profiles (which can change as viewing preferences change) (column 35, lines 12-16 and column 39, lines 1-16). Since having the same demographics does not automatically entail that these customers "like" the same video, the results from a test audience based on preference groups (clusters) rather than demographics will be different. This is understandable because the teachings of Herz are directed to a specifically different purpose. To say that Herz uses demographics, like the presently claimed invention, in deciding who "likes" a video, runs counter to the emphasis that Herz puts on preference (in the form of customer profiles) to decide which type of videos a customer "likes". It would not be obvious for one to alter the teachings of Herz. Nor would one be motivated to alter the teachings of Herz in a way that is contrary to those teachings.

As to claim 5, in addition to the reasons stated above with regard to claims 1 and 4, the method used in Herz utilizes certain demographic requirements to obtain "clusters" of viewers. This "cluster" method is applied to customers that are already registered. In a case when active volunteering is necessary, such as with the presently claimed invention, Herz has no answer for how demographic requirements can be used to accept or reject volunteers.

As to claims 6 and 7, in addition to the reasons stated above with regard to claims 1, 4 and 5, Herz obtains a test audience by "clustering" current customers using a method that can include demographic information. It is assumed that if a customer declines to participate, they are replaced by another passive volunteer from the current customer registry, who meets the requirements of the "cluster" group desired (column 13, lines 29-31). In light of the variations that can be utilized to establish a test audience in my method, the necessity for a selected candidate database can be better illustrated by using an example with two different test screenings. After a candidate database is created for a particular demographic requirement (needed for both test screenings), two separate selected candidate databases (one for each test screening) can be created from the candidate database by randomly selecting out volunteers

*Application No. 09/915029*

*Page 10*

*Amendment*  
*Attorney Docket No. F46.2B-13069-US02*

(candidates). This amounts to the "clustering" of two separate groups from the candidate database, using random selection to form the two selected candidate databases. In this example, the candidate database could have been created directly from the registrant database (similar to Herz) or from active volunteers (provided they meet the demographic requirements) responding to notification of the test screenings with a sign-up deadline. The use of active volunteers and selected candidate databases seems distinctly different from what is used in Herz.

As to claim 8, in addition to the reasons stated above with regard to claim 1, Herz does not teach obtaining an explicit agreement from customers because Herz is not concerned with protecting the security and legitimacy of the results obtained from a test screening. As such, one would not be motivated to alter the disclosed teaching to do so. The results obtained in the Herz method are mostly used internally. The originator of a video to be test screened would want any results to be as accurate as possible. In regards to Von Kohorn, participating as a contestant can not be equated with volunteering to test screen a video, as asserted in the rejection. In the presently claimed invention, volunteering would include an obligation to test screen a video. No obligation exists for potential contestants in Von Kohorn.

As to claim 9, in addition to the reasons stated above with regard to claim 1, any test screening would have to be conducted using at least a minimum number, N, of audience members as pre-determined by the originator of the test video or others. The number could be greater if all active volunteers who qualify are allowed to participate. This method is not accounted for in Herz, because it uses current customers or panel members in its "test screening" (column 13, lines 25-29). There is no cited motivation to alter the teachings of Herz, as asserted in the rejection.

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (*Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985.) The asserted combination of references is a piece-meal reconstruction of the prior art patents in the light of Applicant's disclosure. "The mere fact that elements of [an invention] may be found in various [references] does not necessarily negate invention." *In re McKenna*, 203 F.2d 717, 721, 97 USPQ 348,

*Application No. 09/915029  
Page 11*

*Amendment  
Attorney Docket No. F46.2B-13069-US02*

351 (CCPA 1953). As such, For the above stated reasons, the claimed invention cannot be considered obvious in light of the cited references. Withdrawal of the rejection is therefore respectfully requested.

(9)

Claims 10 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz (US 6088722) in view of Von Kohorn US 2001/0003099 and further in view of Haithman. A full account of the rejection may be found in paragraph 9 of the official action on pages 15-17.

Applicant respectfully traverses. In addition to the comments laid out above in regard to claims 1 and 11, claims 10 and 14 are similarly not obvious. Herz, as mentioned above, does not teach using a verification code to verify that a customer or test audience member has actually viewed the test video. The purpose and processes behind the teachings of Herz don't require such a code. Nor is there motivation incorporate such a code.

In regards to Haithman, merely having a code (specified information) shown during a video does not confirm that someone watched the entire video. In the presently claimed invention, test audience members, by volunteering, are agreeing to watch the entire test video ahead of time. This prior commitment and the fact that a verification code may be shown any time during the test video (or more than one code being shown at different times) ensures that test audience members will watch the entire test video. Simply using what Haithman teaches does nothing to guarantee that people will watch a TV show (i.e. video). It may act to lure them in, but there is no commitment to follow through on. to suggest that Haithman teaches a "verification code" is an over statement, since it only verifies that someone happened to see the code and enter the sweepstakes. As such, withdrawal of the rejection is respectfully requested.

*Application No. 09/915029*  
*Page 12*

*Amendment*  
*Attorney Docket No. F46.2B-13069-US02*

The application should now be in condition for allowance. Allowance is therefore earnestly solicited. If the Examiner would like to further discuss the case, he is encouraged to contact the undersigned.

Respectfully submitted,

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